

REMARKS

Claims 1-20 were previously pending in this patent application. Claims 1-20 stand rejected. Herein, Claims 1, 8, 16, and 17 have been amended. Accordingly, after this Amendment and Response, Claims 1-20 remain pending in this patent application. Further examination and reconsideration in view of the claims, remarks, and arguments set forth below is respectfully requested.

35 U.S.C. Section 102(b) Rejections

Claims 1-4 and 7-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Iwata et al., U.S. Patent No. 6,535,749 (hereafter Iwata). These rejections are respectfully traversed.

Independent Claim 1 recites (as amended):

A handheld computer comprising:
a processor module comprising a processor and ***a display for displaying one or more objects, wherein each object corresponds with one of a plurality of actions;***
a sliding display cover moveably coupled to said processor module;
a sensing device coupled to said processor module and to said sliding display cover for ***sensing a position on said display of an edge of said sliding display cover, wherein said position corresponds with a location of a displayed object on said display;***
and
a device driver for ***performing an action corresponding to said displayed object which corresponds with said position,*** wherein said performance of said action is initiated by a user. (emphasis added)

It is respectfully asserted that Iwata does not disclose the present invention as recited in Independent Claim 1. In particular, Independent Claim 1 recites the limitations, "***a display for displaying one or more objects, wherein each object corresponds with one of a plurality of actions,***" (emphasis added), "a sliding display cover...a sensing device...for ***sensing a position on***

said display of an edge of said sliding display cover, wherein said position corresponds with a location of a displayed object on said display," (emphasis added), and " a device driver for **performing an action corresponding to said displayed object which corresponds with said position,**" (emphasis added). That is, the sliding display cover, the sensing device, and the device driver provide functionality that is analogous to the "mouse input device". With the sliding display cover, the sensing device, and the device driver, a user is able to select objects displayed on the display to initiate performance of an action as is done by "clicking" on the displayed object with the "mouse input device". For example, the edge of the sliding display cover is positioned at a location of a displayed object on the display. Upon initiation by a user, the device driver performs an action corresponding to the displayed object which is at the position on the display of the edge of the sliding display cover.

In contrast, Iwata fails to disclose functionality that is analogous to the "mouse input device", as in the invention of Independent Claim 1. Iwata is silent as to the interaction of the slide cover (7), cover switch (9), and displayed objects on the display (4). [Iwata; Figures 1-3]. Moreover, Iwata shows that slide cover (7) slides to different positions with respect to the display (4) in Figures 1 and 2. However, there is no displayed object on the display (4). Further, Iwata shows changing the display area for displaying information and the displaying direction of information according to the position of the slide cover (7) instead of displaying objects on the display (4) and showing a relationship between the position of the slide cover (7) and displayed objects on the display (4), wherein the relationship leads to an action being performed.

Continuing, at page 4 of the Office Action, it is stated that the control unit (Figure 42) that controls the display or LCD unit is equivalent to the claim limitation “a device driver for performing an action to the displayed object”. However, the claim limitation states “a device driver for performing an action corresponding to the displayed object” instead of stating “a device driver for performing an action to the displayed object”. Moreover, the control unit of Figure 42 is implemented in a device (Figures 35 and 36) having a door cover instead of a sliding cover. Also, Iwata is silent as to the interaction of the door cover (202), cover switch (207), control unit (231), and displayed objects on the display of Figures 35, 36, and 42. There is no description that each displayed object corresponds with one of a plurality of actions, as in the invention of Independent Claim 1. Furthermore, Iwata fails to disclose a sensing device for sensing a position on the display of an edge of the sliding display cover, wherein the position corresponds with a location of a displayed object on the display, and fails to disclose a device driver for performing an action corresponding to the displayed object which corresponds with the position, as in the invention of Independent Claim 1.

Therefore, it is respectfully submitted that Independent Claim 1 is not anticipated by Iwata and is in condition for allowance.

Dependent Claims 2-4 and 7 are dependent on allowable Independent Claim 1, which is allowable over Iwata. Hence, it is respectfully submitted that Dependent Claims 2-4 and 7 are patentable over Iwata for the reasons discussed above.

Independent Claim 8 recites (as amended):

A method of selecting an option in an electronic device comprising a processor module and a sliding cover, said method comprising:

- a) **displaying** one or more objects on a display screen of said processor module, wherein **each displayed object corresponds with one of a plurality of actions of said electronic device**;
- b) selecting an action of said electronic device, wherein **said selecting comprises positioning an edge of said sliding cover adjacent to an object corresponding with said action**;
- c) activating a selection device of said electronic device; and
- d) invoking said action of said electronic device in response to said activating. (emphasis added)

It is respectfully asserted that Iwata does not disclose the present invention as recited in Independent Claim 8. In particular, Independent Claim 8 recites the limitations, "**displaying** one or more objects on a display screen of said processor module, wherein **each displayed object corresponds with one of a plurality of actions of said electronic device**," (emphasis added), and, "**selecting an action of said electronic device, wherein *said selecting comprises positioning an edge of said sliding cover adjacent to an object corresponding with said action***," (emphasis added). In contrast, Iwata shows that slide cover (7) slides to different positions with respect to the display (4) in Figures 1 and 2. However, no object is displayed on the display (4). There is no description that a displayed object corresponds with an action, as in the invention of Independent Claim 8. Hence, Iwata fails to disclose displaying one or more objects on a display screen of the processor module, wherein each displayed object corresponds with one of a plurality of actions of the electronic device, and fails to disclose selecting an action of the electronic device, wherein the selecting comprises positioning an edge of the sliding cover adjacent to an object corresponding with the action, as in the invention of Independent Claim 8.

Therefore, it is respectfully submitted that Independent Claim 8 is not anticipated by Iwata and is in condition for allowance.

Dependent Claims 9-15 are dependent on allowable Independent Claim 8, which is allowable over Iwata. Hence, it is respectfully submitted that Dependent Claims 9-15 are patentable over Iwata for the reasons discussed above.

Independent Claim 16 recites (as amended):

A computer readable medium containing executable instructions which, when executed in a handheld computer comprising a display, causes the handheld computer to configure a visual output of the display, comprising instructions for:

sensing a position on said display of an edge of a sliding display cover;

generating said visual output on said display, wherein said visual output comprises visual objects arranged to be viewable in response to said position, wherein ***said generating comprises one of scaling the size of said visual output, implementing a scrolling feature for said visual output, and any combination thereof.*** (emphasis added)

It is respectfully asserted that Iwata does not disclose the present invention as recited in Independent Claim 16. In particular, Independent Claim 16 recites the limitation, "wherein ***said generating comprises one of scaling the size of said visual output, implementing a scrolling feature for said visual output, and any combination thereof,***" (emphasis added). In contrast, Iwata shows that slide cover (7) slides to different positions with respect to the display (4) in Figures 1 and 2. Moreover, Iwata states that, based on the detected location of the slide cover (7), a display switch limits the display area of display (4) to the area, for example, shown in Figure 1, and performs turning process for the display characters and symbols by 90 degrees. [Iwata; Col. 13, lines 42-60]. However, Iwata fails to disclose generating the visual output, wherein the generating comprises one of scaling the size of the visual output, implementing a scrolling feature for the visual output, and any combination

thereof, as in the invention of Independent Claim 16. Therefore, it is respectfully submitted that Independent Claim 16 is not anticipated by Iwata and is in condition for allowance.

Dependent Claims 17-20 are dependent on allowable Independent Claim 16, which is allowable over Iwata. Hence, it is respectfully submitted that Dependent Claims 17-20 are patentable over Iwata for the reasons discussed above.

35 U.S.C. Section 103(a) Rejections

Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata et al., U.S. Patent No. 6,535,749 (hereafter Iwata) in view of Osborn, U.S. Patent Application Publication No. US2002/0169924 (hereafter Osborn). These rejections are respectfully traversed.

Dependent Claims 5-6 are dependent on allowable Independent Claim 1, which is allowable over Iwata. Hence, it is respectfully submitted that Dependent Claims 5-6 are patentable over Iwata for the reasons discussed above. As will be described below, the reference Osborn is disqualified from being used to support the rejection under 35 U.S.C. Section 103(a).

Statement Pursuant to 35 U.S.C. Section 103(c) to Disqualify Patent Application Publication

The inventive entity of the present Patent Application No. 10/006,538 is different from the inventive entity of U.S. Patent Application Publication No. US2002/0169924 since all inventors are not the same for the present Patent

Application No. 10/006,538 and U.S. Patent Application Publication No. US2002/0169924. Moreover, present Patent Application No. 10/006,538 and U.S. Patent Application Publication No. US2002/0169924 were, at the time the invention of present Patent Application No. 10/006,538 was made, owned by or subject to an obligation of assignment to the same person, PALM Inc.

The above statements alone are sufficient to disqualify U.S. Patent Application Publication No. US2002/0169924 from being used in a rejection under 35 U.S.C. Section 103(a) against the claims of present Patent Application 10/006,538 since U.S. Patent Application Publication No. US2002/0169924 qualifies as prior art only under 35 U.S.C. Section 102(e) to support the rejection pursuant to 35 U.S.C. Section 103(a).

CONCLUSION

It is respectfully submitted that the above claims, arguments and remarks overcome all rejections and objections. All remaining claims (Claims 1-20) are neither anticipated nor obvious in view of the cited references. For at least the above-presented reasons, it is respectfully submitted that all remaining claims (Claims 1-20) are in condition for allowance.

The Examiner is urged to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Respectfully submitted,

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Dated:

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